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10/688,886

10/21/2003

Rodney George Wade

CULLE-14

2767

23599

7590

07/20/2006

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EXAMINER

PRICE, CRAIG JAMES

ART UNIT

PAPER NUMBER

3753

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,886

Applicant(s)

WADE, RODNEY GEORGE

Examiner

Craig Price

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Correction is required in claim 10, line 2 as follows:

the limitation "1 0" , should be --1--.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The amendment filed 8 May 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claim 1, line 8, uses the claimed limitation "other than one", and in line 16 of claim 1, the claimed limitation of "0.005" were not part of the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

3. The drawings were received on 8 May 2006. These drawings are unacceptable because they would introduce new matter. The added material which is not supported by the original disclosure is as follows: The added reference number indicated as 19 does not appear to be the same component as the original reference number 19, furthermore this added item is located at a different height in the tank which may indicate that the material from which the item was made is different or there is some other influence for the reason as to why the two items indicated as 19 are not at the same level.

Since the drawings filed 5/8/2006 are unacceptable and not entered, the drawings filed 10/21/2003 remain of record. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "plurality of floating balls within the collection chamber", as recited in claim 10, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,2,3,5,8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wade (AU-B-16551/95) in view of Wallis (5,407,091).

Regarding claims 1,2,3,5,8 and 9, Wade discloses a first flush water diverter comprising a T-piece (6) with associated rainwater collection chamber, which T-piece is adapted for connection in a rainwater flow path to intercept the flow of rainwater from a roof into a downpipe or directly to a storage or usage area, the collection chamber (1) including a float (5) which seals on a seat adjacent a T-piece inlet to the collection chamber when the collection chamber is charged with rainwater and having a diameter which is an integral multiple of the diameter of the T-piece inlet, the collection chamber

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is a pvc tube having a diameter of approximately 300 mm (Col. 6, Lns. 1-5), the pvc tube has a length of between about 225 mm and 2005 mm (Col. 6, 14-19), and wherein the collection chamber includes an outlet and associated flow control valve (12) to regulate the flow of diverted rainwater from the collection chamber, and wherein a hose connection (11) is fitted to the flow control valve as shown in Figure 1, wherein a filter screen (15,16) is provided at the outlet as seen in Figure 2, wherein the float is a ball which freely floats on the surface of the rainwater which collects in the collection chamber as shown in Figure 5 and in (Col. 4, Lns. 2 and 3), and a collection chamber having a capacity defined by the equation in the form of fall pipe volumes of 5 to 100 litres (Col. 6, Lns. 6-14).

Wade is silent to the claimed limitation regarding an integral multiple other than one.

At the time the invention was made it would have been an obvious matter of design choice to one of ordinary skill in the art to utilize a pipe diameter with an integral multiple other than one, since such items are readily available.

Secondly, regarding the rainwater carrying capacity formula, Wallis discloses in column 2, lines 63 through column 3, line 2, the optimization of a rainwater diverter tank on the basis of foreign matter in the equation, therefore it would have been obvious for a skilled artisan to optimize the size of the collection chamber based on the roof size and environmental surroundings based on some type of relative location for instance in heavy or light pollution areas, in order to determine the size of the collection chamber.

6. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wade and Wallis, as applied to claim 1, and further in view of Sill (US 1,460,613).

Regarding claims 4, and 6, Wade and Wallis teaches all of the claimed invention, but lacks the collection chamber is adapted for support on a stand or for connection to a wall or post and lacks a conical cap connects the T-piece to the collection chamber.

Firstly, Sill teaches the use of a rain water supply system on a stand, as seen in Figures 1 and 2.

In view of the Sill patent, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the collection chamber of Wade and Wallis with the stand of Sill in order to provide a collection chamber which would be out of the reach of small children for safety concerns.

Secondly, Sill teaches the use of a conical cap (17, the cone shape is estimated to have an included angle of about 160 degrees, shown best in figure 3) connecting the T piece to the collection chamber, as shown in Figure 2.

In view of the Sill patent, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the collection chamber of Wade and Wallis with the conical cap of Sill, in order to provide a collection chamber cap that extend the life of the chamber by not rusting as quickly as in the surface were flat.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Wallis (US 5,407,091).

Regarding claim 7, APA teaches all of the claimed invention, but lacks a conical receptacle is fitted to the lower end of the collection chamber which houses the outlet.

Wallis teaches the use of a conical receptacle is fitted to the lower end of the collection chamber, which houses the outlet, as shown in Figure 2.

In view of the Wallis patent, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the collection chamber of Wade with the conical receptacle of Wallis, in order to provide a chamber which would drain out all of the possible rainwater due to the conical shape.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over APA. Regarding claim 10, APA teaches all of the claimed invention, but lacks the plurality of floating balls within the collection chamber. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a plurality of floating balls, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Response to Arguments

9. Applicant's arguments filed 8 May 2006 have been fully considered but they are not persuasive.

In regards to your first argument, concerning the collection chamber having an integral multiple other than one, this is readily resolved using an off the shelf pipe with a size in ½ increments in which a skilled artisan would use to accommodate the size constraints surrounding the apparatus.

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In regards to your next argument concerning that there is no consideration of a pollution factor in the Wade reference, clearly in Column 6, lines 11-13, "bird and animal droppings were simulated using plastic beads", indicates that a pollution factor is considered and was being used optimize the size of the collection chamber, furthermore varying the pollution factor would have been an obvious part of the optimization process.

In regards to your argument concerning the use of Sill as a reference, Sill is being used to meet the claimed limitation within the scope the the subject claims 4 and 6 which require a stand and also a conical cap, Sill stand is clearly shown and the conical cap of Sill has an included angle estimated at about 160 degrees as shown in figure 3.

In regards to your next argument concerning the use the Wallis reference, Wallis' rainwater storage tank clearly teaches the use of a conical receptacle fitted to the lower end of the collection chamber which houses an outlet as shown in figure 2.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig Price whose telephone number is (571) 272-2712. The examiner can normally be reached on 7AM - 5:30PM M-R.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Keasel can be reached on (571) 272-4929. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CP

13 July 2006



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